



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/760,172

01/16/2004

James Charles Wilson

HA-HSS-1

1286

26479

7590

12/23/2008

STRAUB & POKOTYLO

788 Shrewsbury Avenue

TINTON FALLS, NJ 07724

EXAMINER

HOSSAIN, TANIM M

ART UNIT

PAPER NUMBER

2445

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/760,172	Applicant(s) WILSON ET AL.	
	Examiner Tanim Hossain	Art Unit 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-23, 25, 26 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-23, 25, 26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (U.S. 2005/0039041) in view of Joao (U.S. 2002/0032583).

As per claim 1, Shaw teaches a portable device comprising: a memory including stored information corresponding to an individual, the memory including: a plurality of data sets, said plurality of data sets including: an individual member data set including at least one of medical information, nutritional information, insurance information, financial information, and appointment information specific to the member (Abstract; paragraphs 0026-0030); and access control information, said access control information including information begin used to limit the amount of access different entities are provided to the content of said plurality of data sets, the amount of access provided by said access control information depending on at least one of the identity of an entity and a type of service to be provided by an entity (0012-0015, 0034-0037); a device interface for providing an external device access to information stored in said memory (Abstract); and a security module for limiting access to the stored information via said device interface in accordance with the access control information included in said memory. While

Art Unit: 2445

Shaw teaches the storage of individual patient information, the reference does not specifically teach the storage of a group of patient information. Joao teaches the storage of patient group information, corresponding to a plurality of individuals who form a group (Abstract, 0157, 0375); multiple data sets corresponding to different members in the group (0014, 0015, 0018, 0024, 0028, 0042, 0157, 0277, 0141, 0144); and a group data set, the group data set including information corresponding to a plurality of members of said group, at least some information in said group data set being aggregated from multiple group member information data sets, said group data set including aggregated information corresponding to at least one of medical information, nutritional information, insurance information, financial information, and appointment information (0014, 0015, 0018, 0024, 0028, 0042, 0157, 0277, 0141, 0144). It would have been obvious to one of ordinary skill in the art to store information of a plurality of patients on the smart card, as taught by Joao in the system of Shaw. The motivation for doing so lies in the fact that having multiple patient information on the smart card would enable a doctor, for example, easy access to the information. The doctor would be able to access medical histories of multiple patients, view pertinent information related to them, and also keep track of appointments, for example. A smart card enables the storage of any type of data, and therefore, the inclusion of multiple patient data would have been envisioned by one of ordinary skill.

As per claim 2, Shaw-Joao teaches the portable device of claim 1, wherein said portable device is a display free device (Shaw: Abstract).

As per claim 3, Shaw-Joao teaches the portable device of claim 1, wherein said device is a smart card, the device further comprising: a processor (Shaw: Abstract); and wherein said device interface is a read/write interface through which information on said smart card can be

Art Unit: 2445

accessed, said security module preventing communication of a portion of said stored information over said read/write interface when an access restriction restricts a user attempting to gain access to said interface via said read/write interface from accessing said portion of information (Shaw: Abstract).

As per claim 4, Shaw-Joao teaches The portable device of claim 3, wherein said security module provides different members of said group different levels of access to said stored information (Shaw: Abstract); and wherein said access control information includes identification information, said identification information including information distinguishing different entities who may attempt to access the memory, said entities including at least one of a member of said group and a service provider (Shaw: Abstract).

As per claim 5, Shaw-Joao further teaches that said access control information includes information used to identify different individual members of said group (Joao: 0030).

As per claim 6, Shaw-Joao further teaches that said access control information includes information used to identify different service providers, said different service providers including at least two of a medical service provider, insurance service providers, credit service provider (Joao: 0029).

As per claim 7, Shaw-Joao further teaches that said individual group member data sets are stored in an encrypted format (Joao: 0323); and wherein said access control information includes information used to decrypt encrypted individual group member data sets, different encryption information being included for at least some different individual group member data sets (Joao: 0323).

Art Unit: 2445

As per claim 8, Shaw-Joao further teaches that said access control information includes information sufficient to determine a decryption key that should be used to decrypt an individual group member data set, different decryption keys being used for different individual group member data sets (Joao: 0323).

As per claim 9, Shaw-Joao further teaches that said different encryption keys are used for information stored in an individual group member data set corresponding to different services (Joao: 0323-0324).

As per claim 10, Shaw-Joao further teaches an access control module limits access to different sets of data stored on said portable device to different entities, said different entities being providers of different types of services (Joao: 0322-0324).

As per claim 11, Shaw-Joao further teaches that said access control module limits the ability of different entities to read different portions of said stored data sets (Joao: 0322-0324).

As per claim 12, Shaw-Joao further teaches that said access control module limits the ability of different entities to updated different portions of said stored data sets (Joao: 0322-0324).

As per claim 13, Shaw-Joao further teaches that said access control module limits a medical entity providing a medical service to reading and updating medical information stored in an individual group member data set corresponding to an individual group member to whom a medical service is being provided (Joao: 0322-0324).

As per claim 14, Shaw-Joao further teaches that said access control module limits the individual group member from obtaining access to the medical information stored in said individual group member data set (Joao: 0322-0324).

Response to Arguments

Applicant's arguments filed on July 7, 2008 have fully been considered, and are respectfully traversed by the new grounds of rejection.

Applicant's arguments filed on October 10, 2008 have fully been considered, but are not persuasive. The independent claims from the invention groups address different aspects of data access, as evidenced by the different classifications. Further, the dependent claims from these invention groups diverge greatly between inventions. For example, Group II includes access-level considerations, where the other groups address general access privileges, without a level system. Group III includes authentication operations, and X-Ray considerations. These differences would require further search and thus incur a burden. As such, the restriction is deemed proper.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2445

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanim Hossain whose telephone number is (571)272-3881. The examiner can normally be reached on 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571/272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tanim Hossain
Patent Examiner
Art Unit 2145

/Larry D Donaghue/

Application/Control Number: 10/760,172

Page 8

Art Unit: 2445

Primary Examiner, Art Unit 2454